UNITED STATES PATENT AND TRADEMARK OFFICE

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ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 August 2006*.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date *20061016*.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

DETAILED ACTION

1.   This office action is filed in response to the amendment filed 8/19/2006.

2.   Claims 1-20 are pending, claims 1, 7, 9, and 15 are independent claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3.   Claims 7, 15, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by

Graham et al (US Patent: 6,804,659, published: Oct 12, 2004, filed Jan. 14, 2000).

With regards to claim 7, Graham et al teaches a method comprising:

- *Accepting document information* (column 5, lines 46-48: whereas, any web page

  document that comprises document information, is used as input).

- *Using the document information to determine content in addition to content of the*

  document: whereas, based on the concepts extracted from the document

  information, additional content is determined (in this case an ad is the additional

  content) (column 6, lines 34-39).

- *Using the determined content, determining further content*: whereas, the

  determined content is the ad that is most relevant (Fig 11A, reference number

  1512, column 15, lines 13-19). A second ad (Fig. 11A, reference number 1514) is

  displayed as further content, and determined by choosing a second ad based on

a ranking score, which indicates that it is broader in terms of concept than the

first ad (column 15, lines 13-19).

- *Combining at least a portion of content of the document and at least a portion of*

  the determined content, and at least a portion of the determined content, and at

  least a portion of the determined further content for presentation to a user (Fig.

  11A, column 15, lines 1-23: whereas, the content of the document, the

  determined content (reference number 1512 is an ad representing the

  determined content), and the further determined content (reference number

  1514) are combined into a browser screen (reference 1503)).

With regards to claim 15, for an apparatus performing a method similar to the method in

claim 7, is rejected under the same rationale.

With regards to claim 20, which depends on claim 7, Graham et al teaches *wherein the*

acts of (b) using the ad document information to determine content in addition to content

of the ad document, and (c) combining at least a portion of content of the ad document

and at least a portion of the determined content for presentation to the user with page

content (as similarly explained in the rejection for claim 1), are performed automatically

by a machine executing machine-executable instructions is explained in claim 9 of

Graham et al (column 18, lines 41-62), for a computer program comprising executable

instructions, automatically performing the acts of (b) and (c).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 1 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graham et al (US Patent: 6, 804,659, published: Oct 12, 2004, filed Jan. 14, 2000).

With regards to claim 1, Graham et al teaches a method comprising:

- *Accepting document information* using web page content, as similarly described in claim 7, and is rejected under the same rationale.

- *Using the document information to determine content in addition to content of the document*, as similarly described in claim 7, and is rejected under the same rationale.

- *Using the determined content, determining further content*, as similarly described in claim 7, and is rejected under the same rationale.

- *Combining at least a portion of content of the document and at least a portion of the determined content, and at least a portion of the determined content for presentation to a user* (as similarly described in claim 7), *together with page content* (the examiner interprets the limitation "page content" in at least two ways: first, page content is interpreted as the output page content generated for display and shown in a web browser (as shown in Fig. 11A: whereas the page content of a browser comprises the document information, as well as the determined content). Secondly, the page content can be the web page content/document-information that was used in the 'Accepting document information' step, as

explained earlier, such that the determined ad content is displayed with the web

page content/document-information (Fig. 11A).)

- *Wherein the page content is not directly used to determine the determined*

  content (Whereas, the page content, with regards to the first interpretation as

  explained above, is not directly used, since the output page content is generated

  as a result from the determining of determined content, as similarly explained

  above. With regards to the second interpretation of page content, as also

  explained above, the web page/document information is not directly (through the

  .definition of directly being: 'without anyone or anything intervening') used to

  determine the determined content, as rather, profile content data is used in

  addition to the web page/document information so as to provide a more

  tailored/fitted version of determined content for display to a user (paragraph

  0005, lines 45-50: whereas profile data is used in addition to the document

  information/web page content)).

However, although Graham et al teaches that the document information accepted is

from a web page, Graham et al does not expressly teach that *the document is at least*

one ad. Yet, Graham et al also teaches that the advertisements displayed are web page

content as well (column 4, lines 51-54: whereas, the advertisements are displayed in a

web browser).

It would have been obvious to one of the ordinary skill in the art at the time of the

invention to have modified Graham et al's system, such that the document information

accepted; would have been a web page comprising an ad as also taught by Graham et

al. The combination would have allowed the client of Graham et al's system to have

obtained additional information based on the ad content retrieved.

With regards to claim 9, for an apparatus performing a similar method to claim 1, is

rejected under the same rationale.

5.   Claims 2, 10, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Graham et al (US Patent: 6,804,659, published: Oct 12, 2004, filed Jan. 14, 2000)

in further view of Bhagavath et al (US Patent: 6,505,169 B1, published: Jan. 7, 2003,

filed: Jan. 26, 2000) and ProductReview (Edmunds.com, Page 1, Jan. 22, 2001).

With regards to claim 2, which depends on claim 1, Graham et al teaches a method

comprising:

- *The at least one ad*, in claim 1, and is rejected under the same rationale.

- *The determined content*, in claim 1, and is rejected under the same rationale.

- An ad database, which stores advertisement meta-data for web advertising

   objects/pages (column 5, lines 17-18: whereas, advertisements are mapped to

   concept related metadata). However, Graham et al does not teach the at least

   one ad *is for a product and wherein* the determined content *is a review for the*

   product.

Bhagavath et al teaches ads with associated metadata, which are stored in a

cache/database (Fig. 1, reference number 125, column 4, lines 35-40). Furthermore,

Bhagavath et al teaches the ad - associated meta data includes display constraints

(column 6, 30-34).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Graham et al's ad-metadata system to have further included display constraints as taught by Bhagavath et al. The combination would have allowed Graham et al's ad selection system to have conditionally displayed ads, not just by concept strength, but also based on additional display constraints.

However, although Graham and Bhagavath et al teach a method for selecting ads based on additional display constraints, they do not expressly teach the at least one ad *is for a product and wherein the determined content is a review for the product.*

ProductReview teaches the *at least one ad is for a product and wherein the determined content is a review for the product* (page 1: whereas, a car is the product, and through inherent display constraints, only additional content concerning a review of the particular car is displayed on the right hand side of the page).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Graham and Bhagavath et al's display constraints to have further included the constraint to display a review for a product, when a product is being browsed, as taught by ProductReview. The combination of Graham et al, Bhagavath et al, and ProductReview, would have allowed Graham's system to have been able to provide product review information when the ad is a product.

With regards to claim 10, which is dependent on claim 9, for an apparatus performing a similar method to claim 2, is rejected under the same rationale.

With regards to claim 17, which depends on claim 2, Graham et al teaches *wherein the acts of (b) using the ad document information to determine content in*

addition to content of the ad document, and (c) combining at least a portion of content of

the ad document and at least a portion of the determined content for presentation to the

user with page content (as similarly explained in the rejection for claim 1), are

performed automatically by a machine executing machine-executable instructions is

explained in claim 9 of Graham et al (column 18, lines 41-62), for a computer program

comprising executable instructions, automatically performing the acts of (b) and (c).

6.   Claims 3, 8, 11, 16, and 18 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Graham et al (US Patent: 6,804,659, published: Oct 12, 2004, filed:

Jan. 14, 2000) in further view of Bhagavath et al (US Patent: 6,505,169 B1, published:

Jan. 7, 2003, filed: Jan. 26, 2000) and CNET (CNET.COM, page 1, December 7, 2001).

With regards to claim 3, which depends on claim 1, Graham et al teaches a method

comprising:

- *The at least one ad*, in claim 1, and is rejected under the same rationale.

- *The determined content*, in claim 1, and is rejected under the same rationale.

- An ad database, which stores advertisement meta-data for web advertising

  objects/pages (column 5, lines 17-18: whereas, advertisements are mapped to

  concept related metadata).

- Furthermore, although Graham and Bhagavath et al teach a method for selecting

  ads based on additional display constraints, as explained in claim 2, they do not

  expressly teach the at least one ad *is for a service and wherein* the determined

  content *is a review for the service.*

CNET teaches at least one ad *is for a service and wherein* the determined content *is a review for the service* (page 1: whereas, 'PC Connection' is the name of the service, and the review is indicated by a "star" ranking system).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Graham et al and Bhagavath et al's display constraints to have further included the constraint to have displayed a review for a service, when a service was being browsed, as taught by CNET. The combination of Graham et al, Bhagavath et al, and CNET, would have allowed Graham et al's system to have been able to have provided service review information when the ad was a service.

With regards to claim 8, which depends on claim 7, Graham et al, Bhagavath et al, and CNET teach *wherein the determined content is one of a review*, in claim 3, and is rejected under the same rationale.

Furthermore, Graham et al teaches *wherein the further determined content is at least one ad relevant to the determined content*, as explained in claim 7, and is rejected under the same rationale.

With regards to claim 11, which depends on claim 9, for an apparatus performing a method similar to claim 3, is rejected under the same rationale.

With regards to claim 16, which depends on claim 15, for an apparatus performing a similar method to the method in claim 8, is rejected under the same rationale.

With regards to claim 18, which depends on claim 3, Graham et al teaches *wherein the acts of (b) using the ad document information to determine content in*

addition to content of the ad document, and (c) combining at least a portion of content of

the ad document and at least a portion of the determined content for presentation to the

user with page content (as similarly explained in the rejection for claim 1), are

performed automatically by a machine executing machine-executable instructions is

explained in claim 9 of Graham et al (column 18, lines 41-62), for a computer program

comprising executable instructions, automatically performing the acts of (b) and (c).

7.   Claims 4, 12, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Graham et al (US Patent: 6,804,659, published: Oct 12, 2004, filed: Jan. 14, 2000)

and Bhagavath et al (US Patent: 6,505,169 B1, published: Jan. 7, 2003, filed: Jan. 26,

2000) in further view of MSN (MSN.COM, page 1, Dec. 7, 2000).

With regards to claim 4, which depends on claim 1, Graham et al teaches a method

comprising:

- *The at least one ad*, in claim 1, and is rejected under the same rationale.

- *The determined content*, in claim 1, and is rejected under the same rationale.

- An ad database, which stores advertisement meta-data for web advertising

  objects/pages (column 5, lines 17-18: whereas, advertisements are mapped to

  concept related metadata).

- Furthermore, although Graham and Bhagavath et al teach a method for selecting

  ads based on additional display constraints, as explained in claim 2, they do not

  expressly teach the at least one ad *is for a product or service and wherein* the

  determined content *is a news story about the product or service.*

MSN teaches at least one ad *is for a product or service and wherein* the determined

content *is a news story about the product or service* (MSN, page 1: whereas, MSN

Messenger is the service, and news about MSN Messenger is provided as additional

content).

It would have been obvious to one of the ordinary skill in the art at the time of the

invention to have modified Graham et al and Bhagavath et al's display constraints to

have further included the constraint to display a news story about a service as taught by

MSN. The combination of Graham et al, Bhagavath et al, and MSN, would have allowed

Graham et al's system to have been able to have provided service news information

when the ad was a service type.

With regards to claim 12, which is depends on claim 9, for an apparatus performing

a method similar to claim 4, is rejected under the same rationale.

With regards to claim 19, which depends on claim 4, Graham et al teaches

wherein the acts of (b) using the ad document information to determine content in

addition to content of the ad document, and (c) combining at least a portion of content of

the ad document and at least a portion of the determined content for presentation to the

user with page content (as similarly explained in the rejection for claim 1), are

performed automatically by a machine executing machine-executable instructions is

explained in claim 9 of Graham et al (column 18, lines 41-62), for a computer program

comprising executable instructions, automatically performing the acts of (b) and (c).

8.   Claims 5 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Graham et al (US Patent: 6,804,659, published: Oct 12, 2004, filed: Jan. 14, 2000) in

further view of Bowman et al (US Patent: 6,006,225, published: Dec. 21, 1999, filed:

Sep. 1, 1998).

With regards to claim 5, which depends on claim 1, Graham et al teaches a

method comprising t*he determined content*, in claim 1, and is rejected under the same

rationale.

However, Graham et al does not teach the determined content *is a search query*

related to the document.

Bowman et al teaches the determined content *is a search query related to the*

document (column 1, lines 55-67, Fig. 9: whereas, based on the contents of a

document, a suggested query is presented to the user).

It would have been obvious to one of the ordinary skill in the art at the time of the

invention to have modified Graham et al's system for determining content to have also

included Bowman et al's system for suggesting a query based on document content.

The combination would have allowed Graham et al's system to have been able to

"efficiently locate the most relevant terms" (Bowman et al, column 2, lines 23-24).

With regards to claim 13, for an apparatus performing a similar method as in

claim 5, is rejected under the same rationale.

9.   Claims 6 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Graham et al (US Patent: 6,804,659, published: Oct 12, 2004, filed: Jan. 14, 2000) in

further view of Weaver (US Application: US 2004/0093558 A1, published: May 13,

2004, filed: Oct. 29, 2003, EEFD: Oct 29, 2002).

With regards to claim 6, which depends on claim 1, Graham et al teaches a method comprising *the determined content*, in claim 1, and is rejected under the same rationale. Furthermore, Graham et al teaches determining the content by going through an advertisement database for related concepts, as explained in claim 1. However, Graham et al does not teach the determined content *is a message from a user group.*

Weaver teaches a message database that stores *messages from a user group* (claim 2).

It would have been obvious to one of the ordinary skill in the art at the time of the invention to have modified Graham et al's advertisement database, which associated advertisements with concepts; to a database that stored messages (as taught by Weaver) which associated messages with concepts. The combination would have allowed Graham et al's system to have been able to determine the most appropriate user group message based on the document content.

With regards to claim 14, which depends on claim 9, for an apparatus performing a similar method to claim 6, is rejected under the same rationale.

Response to Arguments

10.   Applicant's arguments filed 8/19/2006 have been fully considered but they are not persuasive.

11.   With regards to the arguments for independent claims 7, and 15, the applicant argues Graham does not teach *using the additional content to determine further content, since the cited portion from the Graham patent as shown below does not teach,*

nor does it imply, that the second ad 1514 is determine using content of the first ad 1512:

"It is noteworthy that the advertisement displayed in area 1514 is directed to a broader aspect of the underlying concept of wearable computers than the advertisement displayed in area 1512" (cited from Applicant remarks).

Additionally, to supplement the cited portion of the Graham patent, that is shown above, the Applicant further explains that "the advertisements have been selected using relevancy determining techniques" (page 9 of Applicant Remarks/Arguments, as also cited in Column 15, lines 17-19 of the Graham Patent), and emphasizes that since the advertisements are retrieved "based upon a determined relevancy between the user's interests, the advertiser's concept's and the content of the current document being viewed". Thus for those cited reasons, the Applicant explains why the Graham Patent does not teach *using additional content to determine further content.*

First, the Examiner agrees that the advertisements have been selected using relevancy determining techniques, as pointed out by the applicant. Secondly, the Examiner also agrees that the advertisements are retrieved based upon a determined relevancy between the user's interests, the advertiser's concept's and the content of the current document being viewed.

However, as established, relevancy is based upon content of document being viewed *and* user interests (among other things). More importantly, the *content of* a first ad (1512) is selected based upon a relevancy score, such that the score is based upon the relevancy of *content* of the input document, with respect to user interests, and

advertisement concepts. Thus, when the _content of_ the second ad (1514) is selected to

be broader aspect/relevancy than the first advertisement (for which relevancy is based

upon the relevancy of _content,_ as explained previously), then the selection based upon

known relevancy of the first ad, is also based upon the content of the first ad, and thus,

the applicant's argument for Graham not teaching _using additional content to determine_

further content, is not persuasive.

Additionally, since the Examiner has shown that Graham teaches _using_

additional content to determine further content, and the determined additional content

(1514) is _combined_ in the same screen as the determined further content (Fig 11A of

Graham, as also explained previously in claim 7), then the Applicant's argument for

Graham not teaching _combining at least portions of the document, the determined_

additional content, and the determined further content for presentation to the user, is not

persuasive.

12.   Applicant's arguments with respect to claims 1 and 9 have been considered, but

are not persuasive. First, the applicant argues that the Graham patent does not teach

the advertisements are web page content, since the advertisements are "separate from

the document". However, the Examiner further points out that Graham teaches the use

of advertisements embedded into the web page, as shown in Fig 11C, and thus, the first

argument is not persuasive. Secondly, the applicant argues that "the portions of the

webpage not embedded with advertisements are directly used to determine the

additional advertisements", however, this argument is not persuasive as similarly

explained in the respective rejections above. Furthermore, the argument is not

persuasive since claim only requires "page content is not directly used to determine the determined content", whereas, the applicant is arguing a more restricted limitation of "the portions of the web page *not embedded with advertisements*", and thus, the applicant's argument is also not persuasive under this premise as well.

13.   Applicant's arguments with respect to claims 2 and 10 have been considered, but are not persuasive. First, the applicant argues that the combination of Graham and Bhagavath, does not compensate for the deficiencies with respect to the amended claims 1, and 9. However, the argument is not persuasive, since the Examiner has shown that amended claims 1 and 9 are still rejected. Secondly the applicant argues that the product review/caption (Edmunds page by ProductReview reference) is apparently just a portion of an authored article and "the photo caption is not determined using ad information". However, the examiner still asserts, that the determined content is a review for the product either because of the display constraints asserted by a program, or due to the display constraints asserted by the author to display the review along with the product content in the same screen. Furthermore, the Examiner is using the teachings of the ProductReview only to show an ad which is a product, and the determined content (using display constraints) is a product review. It has already been shown/explained that the combination of Graham and Bagavath include the capability to *display the determined content* (using display constraints), *based upon the at least one ad*, and thus, the ProductReview reference is merely used to include the prior teachings that the *determined content (using display constraints) is a review*, and also to show the prior teachings of the *document information being an ad*. Thus, the final combination

(Graham, Bagavath, and ProductReview), produces the necessary elements to show

the applicant's argument is not persuasive. Thirdly, although the applicant argues

claims 2 and 10 are not rendered obvious, since they do not compensate for the

deficiencies of the Graham patent with respect to amended claims 1 and 9, it is not

persuasive, since it has been shown by the Examiner that claims 1 and 9 are rejected.

Lastly, the applicant argues the proposed combination is apparently the product of

impermissible hindsight. However, in response to applicant's argument that the

examiner's conclusion of obviousness is based upon improper hindsight reasoning, it

must be recognized that any judgment on obviousness is in a sense necessarily a

reconstruction based upon hindsight reasoning. But so long as it takes into account

only knowledge which was within the level of ordinary skill at the time the claimed

invention was made, and does not include knowledge gleaned only from the applicant's

disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170

USPQ 209 (CCPA 1971).

14.   Applicant's arguments with respect to claims 3, 8, 11, and 16 have been

considered, but are not persuasive. First, the applicant argues that the combination

does not compensate for the deficiencies of the Graham patent with respect to the

amended claims 1, and 9. However, this argument is not persuasive since the Examiner

has shown amended claims 1 and 9 to be rejected. Second, the applicant argues the

combination (Graham and Bhagavath) does not compensate for the deficiencies of the

Graham patent with respect to the amended claims 7 and 15. However, this argument is

not persuasive since the Examiner has shown/explained 7 and 15 to be rejected. The

applicant makes a third argument (with respect to the teachings of CNET), stating "the

service review is not determined using ad information". However, the Examiner is using

the teachings of the CNET only to show an ad which is a service, and the determined

content (using display constraints) is a review for the service. It has already been

shown/explained that the combination of Graham and Bagavath include the capability to

display the determined content (using display constraints), *using the at least one ad*,

and thus, the CNET reference is merely used to include the prior teachings that the

determined content (using display constraints) is a review for the service, and also to

show the prior teachings of the *document information being an ad*. Thus, the final

combination (Graham, Bhagavath, and CNET), produces the necessary elements to

show the applicant's argument is not persuasive. The applicant makes a fourth

argument, that "the service review is not futher information determined from additional

content which was determined from document content". However, the Examiner is using

the teachings of the CNET only to show an ad which is a service, and the determined

content (using display constraints) is a review for the service. It has already been

shown/explained that the combination of Graham and Bagavath include the capability of

further information determined from additional content which was determined from

document content, and thus, the CNET reference is merely used to include the prior

teachings that the *determined content (using display constraints) is for a review for the*

service, and also to show the prior teachings of the *ad is for a service*. Thus the final

combination (Graham, Bhagavath, and CNET) produces the necessary elements to

show the applicant's argument is not persuasive. With respect the applicant's fifth

argument that "the proposed combination (Graham, Bhagavath, and CNET) would not

still compensate for the deficiencies, discussed above, of the Graham patent with

respect to amended claims 1 and 9, and thus claims 2 and 11 are not rendered

obvious", is not persuasive since amended claims 1 and 9 have been shown/explained

to be rejected. With respect to the applicant's sixth argument that "the proposed

combination of (Graham, Bhagavath, and CNET) would still not compensate for the

deficiencies, discussed above, of the Graham patent with respect to claims 7 and 15,

and thus, claims 8 and 15 are not rendered obvious", is not persuasive, since the

examiner has shown/explained 7 and 15 to be rejected. With respect to the applicant's

last argument that "the proposed combination is apparently the product of impermissible

hindsight", it must be recognized that any judgment on obviousness is in a sense

necessarily a reconstruction based upon hindsight reasoning. But so long as it takes

into account only knowledge which was within the level of ordinary skill at the time the

claimed invention was made, and does not include knowledge gleaned only from the

applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d

1392, 170 USPQ 209 (CCPA 1971).

15.   Applicant's arguments with respect to claims 4 and 12 have been considered, but

are not persuasive. First, the applicant argues the combination (Graham and

Bhagavath) does not compensate for the deficiencies, discussed above, of the Graham

patent with respect to amended claims 1 and 9. However, this argument is not

persuasive since the Examiner has shown/explained amended claims 1 and 9 to be

rejected. Second, the applicant argues that "based merely on the page printout, the

applicants believe that the news about MSN messenger was not determined using ad

information, but is simply part of an authored article", and thus, claims 4 and 12 are not

rendered obvious by the combination of (Graham, Bhagavath, and MSN). However, the

Examiner is using the teachings of the MSN only to show an ad which is a service, and

the determined content (using display constraints) is a news story for the service. It has

already been shown/explained that the combination of Graham and Bagavath include

the capability of *further information determined from additional content which was*

determined from document content (ad), and thus, the MSN reference is merely used to

include the prior teachings that the *determined content (*using *display constraints) is for*

a news story for the service, and also to show the prior teachings of the *ad* is *for a*

service. Thus the final combination (Graham, Bhagavath, and CNET) produces the

necessary elements to show the applicant's argument is not persuasive. Third, the

applicant argues that "the proposed combination (Graham, Bhagavath, and CNET)

would still not compensate for the deficiencies, discussed above, of.the Graham patent

with respect to the amended claims 1 and 9, and thus, claims 4 and 12 are not rendered

obvious for at least this additional reason". However, this argument is not persuasive

because the Examiner has shown/explained amended claims 1 and 9 to be rejected.

Lastly with respect to the argument that the proposed combination (Graham,

Bhagavath, and CNET) "is the product of impermissible hindsight", it must be

recognized that any judgment on obviousness is in a sense necessarily a reconstruction

based upon hindsight reasoning. But so long as it takes into account only knowledge

which was within the level of ordinary skill at the time the claimed invention was made,

and does not include knowledge gleaned only from the applicant's disclosure, such a

reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA

1971).

16.   Applicant's arguments with respect to claims 5 and 13 have been considered, but

are not persuasive. First, the applicant argues that "the search query information is not

generated from ad document information", and consequently, claims 5 and 13 are not

rendered obvious by Graham and Bowman. However, it has already been explained

that Graham teaches *determining/generating/*instantiating *content from ad document*

information, in the respective independent claims 1 or 9. Additionally, the applicant

specifically points out "the related terms are generated using query term correlation

data", and the examiner agrees, as explained in the rejection, the query is presented to

the user based on a document, and the examiner further explains the document is the

query correlation data file. Thus, the applicant's argument is not persuasive. Secondly,

the applicant argues that "the combination does not compensate for the deficiencies of

the Graham patent, discussed above, with respect to amended claims 1 and 9".

However, this argument is not persuasive since the examiner has shown/explained the

amended claims 1 and 9 to be rejected. Lastly, the applicant argues the "combination

(Graham, and Bowman), is apparently the product of impermissible hindsight".

However, it must be recognized that any judgment on obviousness is in a sense

necessarily a reconstruction based upon hindsight reasoning. But so long as it takes

into account only knowledge which was within the level of ordinary skill at the time the

claimed invention was made, and does not include knowledge gleaned only from the

applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d

1392, 170 USPQ 209 (CCPA 1971).

17.   Applicant's arguments with respect to claims 5 and 13 have been considered, but

are not persuasive. First, the applicant argues, "the message is not generated from ad

document information as claimed", and consequently, claims 6, and 14 are not rendered

obvious by the Graham patent and Weaver publication for at this reason. However, it

has already been explained that Graham teaches *determining/generating/*instantiating

content form ad document information, in their respective claims 1 or 9. Additionally, as

also explained, the messages are stored in a database from a user group. Since the

Graham patent for storing a database of concepts, was modified, with a database

holding a separate type of data (such as those of messages, taught by Weaver), then

the combination of Graham and Weaver produces a message that is generated from ad

document information (since the additional content determined will now be a message

from user group), thus the argument is not persuasive. Second, the applicant argues,

"the combination (Graham and Weaver), does not compensate for the deficiencies of

the Graham patent, discussed above, with respect to amended claims 1 and 9".

However, the Examiner has shown amended claims 1 and 9 to be rejected, and thus

the argument is not persuasive. Lastly, the applicant argues "the proposed combination

(Graham and Weaver) is apparently the product of impermissible hindsight". However, it

must be recognized that any judgment on obviousness is in a sense necessarily a

reconstruction based upon hindsight reasoning. But so long as it takes into account

only knowledge which was within the level of ordinary skill at the time the claimed

invention was made, and does not include knowledge gleaned only from the applicant's

disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170

USPQ 209 (CCPA 1971).

18.   With respect to claims 2-6, 8, 11-14, and 16, Applicant's additional assertion that

Examiner failed to state *prima facie* obviousness rejections throughout the previous

Office action for lack of proper motivation is rendered moot, as this argument is found

not to be persuasive. More specifically, Applicant has failed to assert specifically why

each combination of cited references would not be obvious to one of ordinary skill in the

art at the time of the invention (no evidence has been presented). It is further noted that

arguments, opinions, or conclusions of Applicant and the Applicant's counsel cannot

take the place of evidence (See *In re Budnick*, 537 F.2d at 538,190 USPQ at 424; *In re

Schulze*, 346 F.2d 600, 145 USPQ 716 (CCPA 1965); *In re Cole*, 326 F.2d 769, 140

USPQ 230 (CCPA 1964)).

Conclusion

19.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wilson Tsui whose telephone number is (571)272-7596. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

STEPHEN HONG
SUPERVISORY PATENT EXAMINER

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W. T.   10/26/06

Wilson Tsui
Patent Examiner
Art Unit: 2178
October 26, 2006